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EXAMINER

JARRETT, SCOTT L

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/748,968	<b>Applicant(s)</b> TARR ET AL.	
	<b>Examiner</b> SCOTT L. JARRETT	<b>Art Unit</b> 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4-11,13-15,18-30,48,49,51,57,58,60,62,92,93 and 96-98 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-11,13-15,18-30,48,49,51,57,58,60,62,92,93 and 96-98 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Non-Final Office Action is in response to Applicant's submission filed July 25, 2008. Applicant's amendment amended claims 1, 4-11, 13-15, 18-30, 48, 49, 51, 57, 58, 60, 62, 92, 93 and 96-98 and canceled claims 2, 3, 12, 16, 17, 31-47, 50, 52-56, 59, 61, 63-91, 94, 95 and 99-110. Currently Claims 1, 4-11, 13-15, 18-30, 48, 49, 51, 57, 58, 60, 62, 92, 93 and 96-98 are pending.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 26, 2008 has been entered.

### ***Response to Amendment***

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

***Response to Arguments***

4. Applicant's arguments with respect to claims 1, 4-11, 13-15, 18-30, 48, 49, 51, 57, 58, 60, 62, 92, 93 and 96-98 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1, 4-11, 13-15, 18-30, 48, 49, 51, 57, 58, 60, 62, 92, 93 and 96-98 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1, 4-11, 13-15, 18-30, 48, 49, 51, 57, 58, 60, 62, 92, 93 and 96-98 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)).

A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject

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matter. Here claims 1, 4-11, 13-15, 18-30, 48, 49, 51, 57, 58, 60, 62, 92, 93 and 96-98 fail to meet the above requirements because they are not tied to another statutory class of invention.

Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See *Benson*, 409 U.S. at 71-72. As *Comiskey* recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." *Comiskey*, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir.1989)). Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 4, 8-11, 15, 18-30, 48-49, 51, 57-58, 60, 62, 92-93, and 96-98 are rejected under 35 U.S.C. 102(e) as being anticipated by Cullen, U.S. Patent Publication No. 2003/020443.

Regarding Claims 1 and 30 Cullen teaches a system and method for surveying a plurality of users with a sequence of questions that is tailored per user/group comprising:

- creating for each user a user (resource) profile containing a tailored sequence of questions and answers (Paragraphs 0008-0009, 0035; Figures 3-4, 13; Tables 1-3);

- creating, at least periodically, one or more (affinity) groups for the users responsive of each of the user profiles, each of the one or more groups having at least one user profile (job category, skills category, business sector, etc.; Paragraphs 0008-0009, 0038, 0041, 0046, 0058, 0119);

- associating each user profile with at least one group (business sector, business arena, business family; Paragraphs 0008, 0038, 0043);

- presenting each user with a sequence of questions from a source containing a plurality of different questions, the sequence and order of each question being independently, asynchronously, and dynamically tailored for each user on an individual basis in response to both an answer received from each user to a previously presented question and a group or combination of groups to which a profile of the user is associated (Paragraphs 0043, 0045, 0051-0052, 0104; 'ASP\_Display\_Order', Tables 1-2; Figures 5D-5G);
- storing the user profile for each user (Paragraph 0079; Figure 8);
- wherein the group comprises *at least one of*: profession, compensation, compensation range, experience, experience range, position or position range (industry, skills, experience, job category, etc.; Paragraphs 0035, 0038, 0051, 0053; Tables 1-3); and
- repeating, at least once, more per user (Paragraphs 0046; Figure 19).

Regarding Claims 4, 10 and 96 Cullen teach a system and method wherein at least one subsequent question from the sequence of questions is presented because *at least one of* the following: popularity, most frequently answered *or* most recently answered within the group or combination of groups (most recently answered question within the group i.e. previous responses by the user/resource; Paragraphs 0008, 0043, 0104).

Regarding Claim 8 Cullen teaches a system and method wherein the questions comprises at least two possible answers (Figures 5A-5D).

Regarding Claim 9 Cullen teaches a system and method wherein the user may select more than one answer to a question (Figures 5A-5D).

Regarding Claim 11 Cullen teaches a method and system further comprising filtering the user profile utilizing a filtering engine that compares the user profile to a set of predefined criteria (filter, match, search; Paragraphs 107-108, 112-113, 116; Figures 14, 15A, 15B16).

Regarding Claim 15 Cullen teaches a system and method further comprising periodically creating a new group by associating at least one of the users to the new group (Paragraphs 0046, 0054, 0058, 103, 0119).

Regarding Claims 18-19 and 48-49 Cullen teaches a system and method further comprising providing a (compensation) report wherein generation of the report is constrained by one or more constraints comprising *at least one of* an attribute of the user profile or a reporting goal (Paragraphs 0036, 107-109, 0111; Figures 5H, 15C).

Regarding Claim 20 Cullen teaches a system and method wherein the reporting goal (criteria) is at least one of: a profile attribute value, a range of profile attribute



values, a Boolean value reflective of a set of values or non-values, a date range, a minimum or maximum count of matching profiles, a question filter, a affinity (group) filter or a match score threshold (Paragraphs 0107-0109, 0115-0116).

Regarding Claims 21 and 22 Cullen teaches a system and method further comprising weighting the constraints (Paragraph 0069; Table 29) to provide a match score and matching between at least a matchfield of a goal and group and a user profile; and generating a match score (Paragraphs 0107-0108, 0113; Figure 14).

Regarding Claim 23 Cullen teaches a system and method further comprising determining at least one best match from a plurality of possible matches (Paragraphs 0107-0108, 0113).

Regarding Claim 24 Cullen teaches a system and method further comprising arranging by order of match score grouped at least at two levels of matches (Paragraphs 0107-0108, 0113).

Regarding Claim 25 Cullen teaches a system and method further comprising:

- providing an aggregated score for the matching (Paragraphs 0107-0108, 0113); and
- weighting the importance of including the match in the report (Paragraph 0069; Figures 14, 15A-15B).

Regarding Claim 26 Cullen teaches a system and method further comprising: classifying each match score as one or deterministic or non-deterministic to meeting the goal (Paragraphs 107-109).

Regarding Claims 27 and 57 Cullen teaches a system and method wherein the goal is *any of*: a personal goal, a result of a plurality of user inputs pertaining to personal aspirations or an external goal, a result of a plurality of arbitrary inputs (Paragraphs 107-109).

Regarding Claim 28 Cullen teaches a system and method wherein the aggregated information comprises statistical information (Paragraphs 107-109, 0111; Figure 14, Element 290).

Regarding Claim 29 Cullen teaches a system and method wherein a report resulting from a personal goal comprises a comparison of a user having a user profile to *at least one of* a plurality of user profiles or a group (Paragraphs 107-109; Figures 14, 15A-15B).

Regarding Claims 51 and 58 Cullen teaches system and method wherein the goal comprises *at least one of* desired: compensation (salary), compensation (salary)

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range, geographic location, firm, range of firms, position or position range (Paragraphs 0107-0108, 0112, 0116).

Regarding Claims 60 and 98 Cullen teaches a system and method wherein the report displays statistical information comprising *at least one of*: average salary, median compensation, salary percentile, standard deviation, trend, profile count, most frequent compensation or most frequent salary (Paragraphs 0107, 0110).

Regarding Claim 62 Cullen teaches a system and method wherein the compensation comprises *at least one of* annual/monthly/weekly salary, hourly rate, bonus, tips, benefits or vacation time (Paragraphs 0083, 0091, 0110; Tables 20-23).

Regarding Claims 92-93, claims 92 and 93 recites similar limitations to Claims 1, 11, 13 and 30 and is therefore rejected using the same art and rationale as applied in the rejection of Claims 1, 11, 13 and 30.

Regarding Claim 97 Cullen teaches a system and method further comprising querying a database of user profiles and a database of groups for a statistical report (Paragraphs 0107-0111; Figures 14, 15A, 15B).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cullen, U.S. Patent Publication No. 2003/020443 as applied to claim 1 above, and further in view of Rosenthal et al., U.S. Patent Publication No. 2002/0133502.

Regarding Claims 5-7, while the utilization of open/free/free form/text questions/answers is a common surveying practice/technique (e.g. write-ins, open ended questions, etc.) Cullen does not expressly teach that the system/method comprises an open text question/answer as claimed.

Rosenthal et al. teach a system and method wherein at least one question is capable of receiving an answer from the user comprising open text wherein the open text allows the user to add a new answer value and wherein the new answer is used as one of a plurality of possible answers posted to another (second) user (Paragraphs 69, 81-84, 111, 134) in an analogous art of surveying for the purpose of capturing and reusing answers (Paragraph 134).

It would have been obvious to one skilled in the art at the time of the invention that the system and method as taught by Cullen would have benefited from utilizing open text questions/answers in view of the teachings of Rosenthal et al.; the resultant system/method enabling surveyors to capture and re-use answers (Paragraph 134).

11. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cullen, U.S. Patent Publication No. 2003/020443 as applied to claim 1 and 11 above, and further in view of Williams et al., U.S. Patent No. U. S. 6,618,734.

Regarding Claims 13 and 14 Cullen does not expressly teach that filtering further comprises: modifying, without user intervention, an answer to a question based on at *least one of* the following: predetermined criterion, at least one filtering rule, consistency with previously answered questions or consistency with answers of a affinity group or combination of affinity groups or wherein modification comprises at least one of omission of an answer and tagging the user profile as inactive as claimed.

Williams et al. teach filtering a user profile, wherein said filtering comprises the application of a rules engine that compares the user profile to a set of predefined criteria (Column 2, lines 35-50, Column 4, lines 10-19, Column 5, lines 55-67, Column 8, lines 25-45, wherein the user's profile is sorted by the system using predefined criteria stored in the system) wherein the filtering step further comprises the step of modifying an answer to said question based on at least consistency with answers of said particular affinity group or combination of said affinity groups (Column 7, lines 5-25, wherein the user modifies an answer). Further, Williams et al. teaches wherein said modification comprises at least one of omission of said answer, and tagging said user profile as inactive (Column 7, lines 5-25, wherein the user modifies an answer based on omission of said answer).

Both Williams et al. and Cullen. teach systems/methods where users are asked questions and the answers are collected via a computer. Cullen teaches user profiles being associated with sets of questions that are like or are correlated with the questions and answers in the participant's profile. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the answer when it appears to be in error in order to more accurately create a profile of the user.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Thomsen, U.S. Patent No. 6,862,596, teach a system and method for generating salary reports comprising a database, filtering user groups, salary surveys and providing salary reports for various salary ranges and/or geographies.

- Plunkett et al., U.S. Patent NO. 7,376,569, teach a system and method for compensation reporting comprising: comparing compensations amongst a plurality of affinity groups (title, geography, etc.), calculating statistical salary/compensation information, job profiles and a database.

- Thomas, U.S. Patent Publication No. 2002/00002482, teach an online survey system and method.

- Coleman et al., U.S. Patent Publication No. 2003/0004748, teach a system and method for compensation analysis.

- Turnasella, U.S. Patent Publication No. 2003/0145015, teach an online compensation analysis system and method comprising: periodic compensation surveys, affinity groups, compensation reports and a database.

- Northrop, Getting the Best from Salary Surveys (1992), teach the well known utilization of compensation/salary surveys to analyze and understand compensation for a plurality of affinity groups.



- Law, Pay Grade Determination Using Cluster Analysis (1995), teach a system and method for identifying/creating a plurality of affinity groups within salary survey data/results utilizing cluster analysis to classify respondents.

- Weinberger, Pare-to-peer: Analyzing Patterns of Strategic Conduct to Select a Compensation Peer Group (2000), teach a system and method for compensation survey comprising creating/defining affinity groups using cluster analysis, competitive analysis reports comprising statistical information.

- How reliable are online salary data (2001), teach a system/method for compensation analysis wherein new affinity groups of users is created periodically responsive to user profiles (new jobs).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SCOTT L. JARRETT whose telephone number is (571)272-7033. The examiner can normally be reached on Monday-Friday, 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Van Doren Beth can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Scott L Jarrett/  
Primary Examiner, Art Unit 3623